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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Envirosolve Corporation

Serial No. 76436149

Joseph R. Cruse, Jr. of The Law Offices of Joseph R. Cruse, Jr. for Envirosolve Corporation.

Anne Madden, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Chapman, Holtzman and Rogers, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On July 30, 2002, Envirosolve Corporation (a California corporation) filed an application to register the mark ECOC on the Principal Register for "computer software, namely software which supports the manual entry of data into a designated form which can be transmitted and/or stored on computer based media." The application is based on applicant's assertion of a bona fide intention to use the mark in commerce. In the original application,

applicant included the following statement: "The Mark 'ECOC' is an abbreviation for Electronic Chain Of Custody."

The Examining Attorney refused registration on the ground that the term ECOC when used on the identified goods of applicant, is merely descriptive of those goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

When the refusal was made final, applicant appealed to the Board. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested.

The Examining Attorney contends that the term ECOC is merely descriptive of a central feature or purpose of applicant's computer programs in that "E" refers to "electronic" and "COC" refers to "chain of custody," making the letters ECOC an acronym for "electronic chain of custody" (as indicated by applicant in its original application); that applicant's website shows use of the term as follows: "Visit www.eCOC.com to see our latest multi-platform electronic Chain-of-Custody (eCOC) data entry application"; that applicant's website also indicates that the prospective purchasers for its goods include industrial clients seeking applicant's expert witness services and providing support data, and field work; that such purchasers are among the classes of people who will

immediately understand that the letters ECOC are an acronym for "electronic chain of custody"; that consumers for applicant's computer software will not need to engage in a multi-stage reasoning process to determine the nature of applicant's goods; that the numerous other meanings of various combinations of the letters "ECOC" suggested by applicant (including that applicant's corporate name begins with the letter "E" and/or that applicant's business deals with the field of the "environment") are not controlling when looking at the mark in the context of the identified goods; and that the combination of the letter "E" with the letters "COC" does not create a unique, incongruous meaning as applied to applicant's goods.

In support of her position, the Examining Attorney submitted (i) printouts from the acronymfinder.com website showing meanings of the initials "e" ("electronic") and "coc" ("chain of custody"); (ii) printouts of a few pages from applicant's website; and (iii) printouts of several excerpted stories retrieved from the Nexis database showing that "chain of custody" is an important issue in connection with applicant's goods -- computer software dealing with data entry, transmission and storage.

Some examples of the excerpted stories retrieved from the Nexis database include the following:

> Headline: Information Life Cycle -- The Real (Legal) Deal
> For electronic records, the court looks at the process or system by which the records were made, how they've been kept, what policies are in place and what practices are followed. Just like a Lincoln letter, the chain of custody can have a bearing on whether records are considered real… . "Transform Magazine," September 1, 2003;
>
> Headline: How To Cut Your Data Losses
> …From a technology point of view, EnCase is the standard in the forensics area and therefore it's used by investigators. But our people are also very well trained on the whole chain-of-custody issue, which generally IT people aren't. … "Computerworld," June 2, 2003; and
>
> Headline: Accommodating New Data
> …The computer discovery expert can help formulate discovery strategy, provide expert testimony and motion support, ensure a defensible chain of custody, locate evidence caches and identify portions of data collections to load into litigations support databases. … "Legal Tech," January 2003.

Applicant urges reversal of the refusal to register on the basis that the Examining Attorney improperly dissected the mark rather than considering the mark as a whole in determining descriptiveness; that applicant's mark is not a series of four separate letters, but rather it is a single word "ECOC" as it does not include any hyphens or periods after any of the letters and thus it should not be split into separate initials; that, in any event, the acronym

"COC" refers to many things other than "chain of custody," such as "certificate of competency" and "certificate of compliance"; that the "e" in its mark could refer to the first letter of applicant's corporate name ("EnviroSolve") or the first letter of the field in which applicant works ("environmental"); that there are three listings in the Acronym Finder for the letters "ECOC," none of which are associated with the various meanings listed for "COC"; and that although applicant's mark is singular and should not be broken into "E" and "COC," applicant argues that the USPTO has allowed "E" marks to be registered as shown by third-party registrations of marks including "e" in combination with other letters or words.

Applicant submitted for the record printouts from its searches of various combinations of the letters "ecoc" and "coc" on the www.acronymfinder.com website.

The test for determining whether a mark is merely descriptive is whether the term or phrase immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used or is intended to be used. See In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001); In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA

1978); In re Eden Foods Inc. 24 USPQ2d 1757 (TTAB 1992); and In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979).

Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the term or phrase is being used or is intended to be used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See In re Consolidated Cigar Co., 35 USPQ2d 1290 (TTAB 1995); and In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991).

Consequently, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985). Rather, the question is whether someone who knows what the goods or services are will understand the term or phrase to convey information about them. See In re Home Builders Association of Greenville, 18 USPQ2d 1313 (TTAB 1990).

We disagree with applicant's argument that its mark should be analyzed as "a single word" rather than as a combination of four letters. Applicant's argument belies the statement it included in its application as originally

filed ("ECOC is an abbreviation for Electronic Chain Of Custody"), as well as applicant's use of the mark on its website ("multi-platform electronic Chain-Of-Custody (eCOC) data entry application"). The lack of periods or hyphens or spaces separating the letters is not necessary in light of applicant's use of and statements regarding its mark.

Therefore, the Board will analyze the issue of mere descriptiveness in relation to applicant's mark as consisting of the letters ECOC. As a general rule, initials are not considered merely descriptive unless they are so generally understood as representing descriptive words as to be substantially synonymous therewith. See Modern Optics, Inc. v. Univis Lens Co., 234 F.2d 504, 110 USPQ 293 (CCPA 1956).

We find that this record establishes that "E" is an abbreviation for "electronic," and "COC" is an abbreviation for "chain of custody"; that "electronic chain of custody" is merely descriptive of applicant's "computer software, namely software which supports the manual entry of data into a designated form which can be transmitted and/or stored on computer based media"; and that the mark ECOC would be recognized by the relevant consumers as no more than an abbreviation of the descriptive phrase.

The listing of "e" as well as applicant's own uses of the letter on its website, establish "e" as meaning "electronic" in the context of applicant's computer software. That is, the evidence shows that this prefix indicates the electronic nature of the goods. See In re Styleclick.com Inc., 57 USPQ2d 1445 (TTAB 2001); and Continental Airlines Inc. v. United Air Lines Inc., 53 USPQ2d 1395 (TTAB 2000).

Further, applicant's use on its website, as well as the Acronym Finder and Nexis evidence, demonstrate that the letters "COC" are clearly an abbreviation for "chain of custody" in the context of applicant's goods; and that "COC" is merely descriptive in relation to applicant's specific computer software. The combined letters "ECOC" would be immediately understood by the relevant consumers (e.g., industrial clients seeking remote field data entry or expert witness services involving support data and field work) as conveying information about a significant feature, function or purpose of applicant's identified goods -- which is to provide or facilitate the electronic chain of custody of data or information. Clearly, applicant's computer software is associated with the electronic aspects of chain of custody of data. Simply put, it would be readily apparent to the purchasers of the identified

computer software that ECOC consists of the prefix "E" followed by the well-known (at least in this field and in this context) abbreviation meaning "chain of custody." See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Omaha National Corporation, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); In re Intelligent Instrumentation Inc., 40 USPQ2d 1792 (TTAB 1996); and In re Time Solutions, Inc., 33 USPQ2d 1156 (TTAB 1994).

Applicant repeatedly makes the point that there are numerous associations possible between these letters and other words. The other associations between the letters "ecoc" and other words are not relevant when considered in the context of applicant's identified goods. That is to say, applicant's argument that the letters could refer to any number of other unrelated matters, such as, "certificate of competency" and several other meanings of various combinations of the letters "e" and "coc," is irrelevant in the context of applicant's goods. See In re Acuson, 225 USPQ 790 (TTAB 1985); and In re Bright-Crest, supra.

The record is clear that the relevant purchasers would immediately understand the meaning of these letters as "electronic chain of custody." That is, the initials ECOC have become generally understood by the relevant purchasers

as being substantially synonymous with the words "electronic chain of custody." In the Modern Optics case, supra, the Court found that the involved initials "CV" were neither the necessary nor the obvious descriptor of the involved product. In the application now before this Board, quite the contrary is shown by the evidence relating to ECOC.

Moreover, the combination of the letters "E" and "COC" does not create an incongruous, ambiguous or unique mark. Rather, applicant's designation ECOC, when used in connection with applicant's identified goods, immediately describes, without need of conjecture or speculation, a primary purpose, function or feature of applicant's goods, as discussed above. Nothing requires the exercise of imagination or mental processing or gathering of further information for purchasers of and prospective customers for applicant's goods to readily perceive the merely descriptive significance of the letters ECOC as pertaining to applicant's goods.

With respect to applicant's typed list of four third-party registrations (showing only the mark and the registration number -- for example, "E DOC 4U, Reg. No. 2498887; SECURIT-E-DOC, Reg. No. 2511829") referenced by applicant in its response to the first Office action, this

evidence is not persuasive of a different result in this case.[1] First, mere typed listings of third-party registrations are not an appropriate way to enter such material into the record, and the Board does not take judicial notice of registrations in the USPTO. See Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992); Cities Service Company v. WMF of America, Inc., 199 USPQ 493 (TTAB 1978); and In re Duofold Inc., 184 USPQ 638 (TTAB 1974).

Second, while uniform treatment under the Trademark Act is an administrative goal, the Board's task in an ex parte appeal is to determine, based on the record before us, whether applicant's mark is merely descriptive. As often noted by the Board, each case must be decided on its own merits. We are not privy to the records of the third-party registration files and, moreover, the determination of registrability of those particular marks by the Trademark Examining Attorneys cannot control our decision in the case now before us. See In re Nett Designs Inc., supra, 57 USPQ2d at 1566 ("Even if some prior registrations had some characteristics similar to [applicant's

[1] In its brief on appeal, applicant included reference to a fifth third-party registration in its typed list. This was untimely under Trademark Rule 2.142(d). However, the Examining Attorney did not object thereto. Accordingly, the Board has considered the typed listing of this fifth third-party registration.

application], the PTO's allowance of such prior registrations does not bind the Board or this court.")[2]

Finally, even if applicant was the first (and/or became the only) entity to use the term "ECOC" in relation to computer software, namely, software which supports the manual entry of data into a designated form which can be transmitted and/or stored on computer based media, such is not dispositive where, as here, the term projects a merely descriptive connotation. See In re Central Sprinkler Co., 49 USPQ2d 1194, 1199 (TTAB 1998); and In re Tekdyne Inc., 33 USPQ2d 1949, 1953 (TTAB 1994). We believe competitors would have a competitive need to use these initials. See 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §11:18 (4th ed. 2001).

Decision: The refusal to register on the Principal Register under Section 2(e)(1) of the Trademark Act is affirmed.

[2] We note that the Examining Attorney further argues with regard to the third-party registrations, (citing a few cases, including In re Styleclick.com, Inc., supra), that in the context of evolving terminology and in relation to computers and the Internet, the "vocabulary used in the computer and electronic fields changes rapidly, and descriptiveness is determined based on the facts and evidence in the record at the time registration is sought." (Brief, p. 4.) There is no evidence of record specifically illustrating this, but we do note that the Examining Attorney's excerpted stories from the Nexis database are very recent.